

## **REMARKS**

Applicant respectfully requests reconsideration of the present application.

Claims 1-12 are pending. Claims 1-2, 5, 7-9 and 11-12 have been amended. No new matter has been added.

### **Objections**

The Examiner objected to the drawings, indicating that Figure 4 should have a legend -Prior Art-. The Examiner also objected claims 1-2, 5 and 8 for informalities.

Applicant has amended Figure 4 to include a legend -Prior Art- and has included replacement sheets herewith. Applicant has also amended claims 1-2, 5 and 8 accordingly. Thus, Applicant respectfully requests that the Examiner remove the objection.

### **Rejection under 35 U.S.C. § 112**

The Examiner rejected claims 1-12 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In particular, the Examiner pointed out that independent claims 1-2, 5, 8 and 11 include limitations that are not supported.

Without admitting to the propriety of this written description rejection, Applicant has amended independent claims 1-2, 5, 8 and 11. Claims 3-4, 6-7, 9-10 and 12 depend, directly or indirectly, one of those independent claims.

Meanwhile, Applicant respectfully submit that the original disclosure expressly supports “a plurality of thumbnail images are capable of being generated from the first compressed code by extracting different portions of the first compressed code” as recited in claims 1, 2 and 8. (See, for example, par. [0069] of Applicant’s Specification). A thumbnail image with a *different* resolution is a *different* thumbnail image. Hence, multiple *different* thumbnail images can be generated with *different* resolutions from a single compressed code of an image such as a JPEG compressed code.

Claims 5 and 11 also contain similar limitations as discussed above regarding claims 1, 2 and 8. Thus, at least for the reasons stated above, the original disclosure expressly supports claims 5 and 11.

Therefore, Applicant respectfully submits that the written-description rejection has been overcome.

### **Rejection under 35 U.S.C. § 103**

The Examiner rejected independent claims 1-2, 5, 8 and 11 under 35 U.S.C. § 103 based on U.S. Patent No. 7,206,804 of Deshpande et al. (“Deshpande”), and further in

view of U.S. Patent No. 6,708,309 of Blumberg et al. ("Blumberg") and U.S. Patent No. 7,127,673 of Iwata et al. ("Iwata"). Applicant respectfully disagrees.

Deshpande does not disclose or suggest, among other things, "setting a resolution of the thumbnail image *in accordance with the format type of the data file*" of claim 1, as the Examiner admitted in the Office Action.

Blumberg does not help Deshpande render claim 1 unpatentable. Blumberg discloses *scalable* documents to overcome communication delay due to the large size of documents including images. Blumberg suggests breaking a document including images into an image-less document and a collection of images that can be dynamically inserted into the image-less document at a designated resolution. (col. 5, ln. 43-51)

The part of Blumberg, cited in the Office Action, explains Internet Imaging Protocol (IIP) for a user to request *portions* of an image, after receiving an image-less document, at a specific resolution. This, however, cannot teach or suggest displaying a *thumbnail* image in claim 1.

"A prior art reference must be considered in its entirety, i.e., *as a whole*." W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); MPEP § 2141.02. In addition to requesting of portions of an image, Blumberg separately mentions, "An initial view of a document (*i.e.*, an image-less document) can include one or more *thumbnails* ...." (col. 18, ln. 49-51) In Blumberg,

thumbnails are expressly provided as a separate and different object from portions of an image, and a portion of an image can be requested *after* a thumbnail may be received in an initial view. In this situation, displaying *portions* of an image in Blumberg cannot suggest or teach displaying a *thumbnail* image according to claim 1.

Even assuming to the contrary, it is clear that Blumberg does not disclose or suggest “setting a resolution of the thumbnail image *in accordance with the format type of the data file*” of claim 1.

Iwata does not fill the gap in Deshpande and Blumberg. Iwata focuses on displaying of an electronic document. Iwata suggests calculating an appropriate font size of text data based on a user’s selection, and calculating an appropriate display size for the text data based on the calculated font size. (col. 10, ln. 1-21) The text data are an element of a document together with other text data or image data. (Figure 3 of Iwata)

The “*format type of a data file*” in claim 1 is not equivalent to a font size of text data in an electronic document of Iwata. Claims are to be given their broadest *reasonable* interpretation *in light of* specification as it would be interpreted by one of ordinary skill in the art. In re Bond , 910 F.2d 831, 833 (Fed. Cir. 1990); M.P.E.P. § 2111.01. Applicant’s Specification sets forth “word processing document,” “color image” and “spread sheet” as examples of the *format type of a data file*. In light of this disclosure, an ordinary skilled person in the art would not interpret the “font type” of Iwata as the *format type*

of a data *file* of claim 1. Thus, Iwata does not teach or suggest “setting a resolution of a thumbnail image *in accordance with the format type of the data file*” as recited in claim 1.

Because neither Deshpande nor Blumberg nor Iwata, nor any combination of those three, discloses or suggests “setting a resolution of a thumbnail image in accordance with a format type of the data file” as recited in claim 1, Applicant respectfully submits that the rejection of claim 1 in view of Deshpande, Blumberg and Iwata has been overcome.

Claims 2, 5, 8 and 11 contain similar, but not identical, limitations compared to the limitations of claim 1. Therefore, at least for the reason stated above, Applicant respectfully submits that the rejection of claims 2, 5, 8 and 11 in view of Deshpande, Blumberg and Iwata has been overcome.

Claims 3-4, 6-7, 9-10 and 12 depend, directly or indirectly, from one of claims 1-2, 5, 8 and 11, and thus, include the limitations set forth in their respective base claims. Therefore, at least for the reason discussed above, Applicant respectfully submits that claims 3-4, 6-7, 9-10 and 12 are allowable.

Applicant, therefore, respectfully submits that the applicable rejections and objections have been overcome, and the pending claims are in condition for allowance.

Please charge any shortages and credit any overages to Deposit Account No. 02-2666. Any necessary extension of time for response not already requested is hereby requested. Please charge any corresponding fee to Deposit Account No. 02-2666.

Respectfully submitted,

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